

## REMARKS

### I. Introduction

Claims **1-63** and **76-82** are currently pending in the present application. Claims **1, 32, 53, 62, and 76** are independent. All claims stand rejected. In particular,

(A) claims **1-63** stand rejected under 35 U.S.C. §101 for allegedly being directed to non-statutory subject matter;

(B) claims **1-2, 6-9, 14, 17, 30-34, 62-63, and 76-82** stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over WO 97/28510 A1 (hereinafter "Smith");

(C) claims **10-12, 15-16, 32, and 51-52** stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Smith in view of U.S. Patent No. 5,029,098 (hereinafter "Levasseur"); and

(D) claims **1-63** and **76-82** are rejected under "the judicially created doctrine of obviousness-type double patenting" in view of various claims of U.S. Patent No. 6,324,520 (hereinafter "Walker").

The Examiner states that claims **3-5, 13, 18, 19-29, 35-50, and 53-61** are generally *directed to allowable subject matter*, subject to traversal of the §101 and "obviousness-type double patenting" rejections thereof. Final Office Action mailed August 11, 2005 as Part of Paper No./Mail Date 31 (hereinafter the "Final Office Action"), pg. 15, bullets 40-41.

Upon entry of this amendment, which is respectfully requested, claims **3-5, 10-16, 18-29, and 35-50** will be canceled without prejudice or disclaimer, claims **1-2, 9, and 76** will be amended, and new claims **84-91** will be added. No new matter is introduced by this amendment.

Applicants hereby respectfully request reexamination and reconsideration of the pending claims in light of the amendments and remarks provided herein and in accordance with 37 C.F.R. §1.114.

## II. The Examiner's Rejections

### A. Rejections under 35 U.S.C. §101

Claims 1-63 stand rejected under 35 U.S.C. §101 for allegedly being directed to non-statutory subject matter. While the §101 ground for rejection is moot with respect to claims 3-5, 10-16, 18-29, and 35-50 cancelled herein, Applicants traverse this ground for rejection with respect to the remaining and new claims as follows.

The sole basis for rejecting remaining claims 1-2, 6-9, 17, 30-34, and 51-61 is the Examiner's allegation that "[f]or a process claim to pass muster [with respect to §101], the recited process must somehow advance the **technological arts**", Final Office Action, pg. 4, lines 10-11 (emphasis added), and the Examiner's finding, that with respect to claims remaining claims 1-2, 6-9, 17, 30-34, and 51-61, "the recited steps...does [sic] not apply, involve, use, or advance the technological arts." *Id.*, pg. 4, lines 13-16.

As explained by the Board of Patent Appeals and Interferences (BPAI) in the recent precedential opinion of Ex parte Lundgren, the purported requirement that all steps must be performed *per se* by use of a computer or other apparatus *is not* a proper basis for rejection. The Board expressly held that the alleged requirement that a claim must be "within the technological arts" has no legal basis:

Our determination is that **there is currently no judicially recognized separate "technological arts" test** to determine patent eligible subject matter under § 101. We decline to create one. Therefore, it is apparent that the examiner's rejection can not be sustained.

Ex parte Lundgren, Appeal No. 2003-2088, 9 (BPAI Oct., 2005); emphasis added.

The examiner's rejection under §101 in Lundgren was based solely on an alleged failure to suggest "computer, automated means, apparatus of any kind" and thus being "outside the technological arts." Accordingly, the Board reversed the §101 rejection.

Every one of remaining claims 1-2, 6-9, 17, 30-34, and 51-61 produces a useful, concrete and tangible result. Indeed, the Examiner states that the remaining claims 1-2, 6-9, 17, 30-34, and 51-61 "produce[] a useful, concrete and tangible result." Final Office Action, pg. 6, bullet 11. The Examiner relies on the same and only basis that was

expressly rejected by the Board in Lundgren – an alleged failure to comply with a legally baseless requirement to recite a computer.

Applicants therefore respectfully request that the §101 rejections of remaining claims 1-2, 6-9, 17, 30-34, and 51-61 be withdrawn. New claims 84-91 are believed patentable at least for depending upon a patentable base claim (independent claim 32), and are also believed to be otherwise compliant with §101.

***B. Rejections under 35 U.S.C. §103(a) – Smith***

Claims 1-2, 6-9, 14, 17, 30-31, 33-34<sup>1</sup>, 62-63, and 76-82 stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Smith. While this §103(a) ground for rejection is moot with respect to claims 14 and 62-63 cancelled herein, Applicants traverse this ground for rejection with respect to the remaining claims as follows.

Applicants note that the limitations of claim 13 (cancelled herein) have generally been incorporated into independent method claim 1 and corresponding independent apparatus claim 76. As claim 13 is deemed by the Examiner to be directed to allowable subject matter, Final Office Action, pg. 15, bullet 41, it is submitted that independent claims 1 and 76 are now in condition for allowance. Claims 2, 6-9, 17, 30-31, and 77-82 are believed to be patentable at least or depending upon a patentable base claim (claims 1 and 76).

Accordingly, Applicants respectfully request that the §103(a) rejections of claims remaining claims 1-2, 6-9, 17, 30-31, and 76-82 be withdrawn.

Applicants note that the utilization of expiration date data to select or determine substitute products (*i.e.*, the limitation generally incorporated into claims 1 and 76 from claim 13) is only one example of a limitation not taught or suggested by Smith. Other examples of providing, selecting, and/or determining substitute products described in Applicants' specification are also not taught or suggested by Smith and Applicants currently plan on pursuing such limitations in other claims and/or in one or more continuing applications.

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<sup>1</sup> Applicants assume that the Examiner inadvertently included claims 33-34 in this ground for rejection, for claims 33-34 depend upon claim 32, which stands rejected separately under a combination of both Smith and Levasseur. Accordingly, Applicants address claims 33-34 in conjunction with claim 32 and the current ground of rejection thereof, elsewhere herein.

***C. Rejections under 35 U.S.C. §103(a) – Smith in view of Levasseur***

Claims 10-12, 15-16, 32-34<sup>2</sup>, and 51-52 stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Smith in view of Levasseur. While this §103(a) ground for rejection is moot with respect to claims 10-12 and 15-16 cancelled herein, Applicants traverse this ground for rejection with respect to the remaining and new claims as follows.

Initially, Applicants note that new claims 84-91 are generally directed to that same and/or similar subject matter as recited by claims 10-12 and 15-16 cancelled herein. The claims have been re-written and/or re-formulated as new claims to better point out their updated dependency upon claim 32 (as opposed to claim 1) as well as to better point out the limitations recited therein with respect to claim 32. Accordingly, new claims 84-91 are believed patentable at least for depending upon a patentable base claim (claim 32), at least some of the reasons for which are set forth immediately below.

Applicants respectfully point out that even if the combination of Smith and Levasseur was supported by a proper motivation and requisite evidence on the record (which Applicants contend that it is not), the combination would still fail to teach or suggest limitations of claim 32. Neither Smith nor Levasseur, either alone or in combination for example, teach or suggest the limitation of *determining from the demand a substitute product for a first product*.

While Smith may describe providing a substitute product to a consumer, Smith does not **determine the substitute product based on product demand**. The Examiner agrees with this contention by stating that Smith “fail[s] to specifically disclose that the substitute product is determined based on a measure of demand for a plurality of products.” Final Office Action, pg. 10, lines 3-4. The Examiner relies upon Levasseur to make up for this deficiency of Smith. The Examiner states, for example, that Levasseur “discloses a vending machine that monitors the historical demand over a period of time for various classes of selectable vendable products and allocating the space within the vending machine based on the historical demand.” *Id.*, at pg. 10, lines 4-7. The Examiner then provides the conclusory statement that it would have been obvious to modify Smith

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<sup>2</sup> Applicants address claims 33-34 in conjunction with claim 32, upon which claims 33-34 depend.

by incorporating the teachings of Levasseur “since a customer will likely purchase a substitute product that has a high demand.” *Id.*, at pg. 10, lines 10-11.

Applicants respectfully note that combining the **demand-based machine stocking** of Levasseur with the **substitute product offerings** of Smith does not read upon, teach, or suggest the limitation of *determining from the demand a substitute product for a first product*. At best, were such a combination supported by a viable motivation (which Applicants maintain that it is not), the Smith vending machine would be **stocked in accordance with product demand** and offer substitute products as described in Smith. Nowhere is there any support for the Examiner’s contention that the combination would teach or suggest the limitation of *determining from the demand a substitute product for a first product*.

Nor has the Examiner provided any support or motivation directed to *why* one of ordinary skill in the art at the time of invention would have looked to Levasseur to modify Smith. Indeed, in the absence of any evidentiary support from the Examiner, it seems that one could have only been potentially motivated to make such a combination to better stock the Smith vending machine. Levasseur, for example, is simply not directed to offering substitute products.

Put differently, Levasseur is directed to solving the problem of how to prevent popular items from being sold out – and thus preventing the situation where a customer can’t get a product that the customer desires. While some presently claimed embodiments (*i.e.*, as recited in 32-34, 51-51, and/or new claims 84-91), in contrast, are directed to the situation where Levasseur fails (*i.e.*, despite best stocking practices, an item the consumer wants is not available). Smith is at least partially related to the same problem of substitutive products, but simply does not describe or suggest features as recited in the pending claims. And, as described herein, Levasseur simply fails to address the same problem or make up for the deficiencies of Smith.

Further, the Examiner’s alleged and broadly stated motivation merely recites a potential advantage of performing the limitation of *determining from the demand a substitute product for a first product*, not a motivation that would have led one to combine the cited references in the manner proposed by the Examiner (said combination which even falls short of describing all claimed limitations).

Accordingly, Applicants respectfully request that the §103(a) rejections of claims remaining claims **32-34** and **51-52** be withdrawn.

***D. Obviousness-type Double Patenting Rejections***

Claims **1-63** and **76-82** are rejected under “the judicially created doctrine of obviousness-type double patenting” in view of various claims of Walker. While Applicants do not necessarily agree with the basis for this rejection, a terminal disclaimer in compliance with 37 C.F.R. §1.321(c) is filed concurrently herewith solely to expedite prosecution of the present application. Accordingly, the double patenting rejection of remaining claims **1-2, 6-9, 17, 30-34, 51-61, and 76-82** is moot.

### III. Conclusion

At least for the foregoing reasons, it is submitted that all claims are now in condition for allowance, or in better form for Appeal, and the Examiner's early re-examination and reconsideration are respectfully requested.

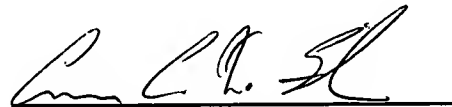
Alternatively, if there remain any questions regarding the present application or the cited reference, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Carson C.K. Fincham at telephone number 203-461-7017 or via electronic mail at [cfincham@walkerdigital.com](mailto:cfincham@walkerdigital.com), at the Examiner's convenience.

### IV. Petition for Extension of Time to Respond

Applicants hereby petition for a **two-month extension** of time and authorize the charge of **\$225.00** to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If any other and/or additional extension of time is required, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,



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